WORLD GRAND DYNAMIC MARKETING SDN BHD v. FJVAA SPA SDN BHD & ORS

HIGH COURT MALAYA, KUALA LUMPUR
WONG KIAN KHEONG JC
[WRIT NO: 22IP-29-06-2015]
27 SEPTEMBER 2016

CIVIL PROCEDURE: *Subpoena – Setting aside – Application for – Whether subpoenas issued to Registrar of Trade Marks' officers frivolous – Whether subpoenaed witnesses in position to give evidence relevant to case – Evidence Act 1950, s. 136(1) – Whether s. 62(1) and (2) of Trade Marks Act 1976 applicable – Whether maker of documents called to fulfil rule against documentary hearsay evidence and to tender primary evidence – Whether subpoenas constitute an abuse of court process – Whether court has discretion under O. 59 r. 3(2) Rules of Court 2012 to award costs of application*

The plaintiff filed an action ('original action') against the defendants for the tort of passing off in respect of a mark used by the plaintiff in its business. The defendants made various counterclaims against the plaintiff. During pre-trial case management of this case, pursuant to O. 34 r. 2(2)(e)(ii) of the Rules of Court 2012 ('RC 2012'), the defendants had classified letters issued by the Intellectual Property Corporation of Malaysia ('MyIPO') as Part C documents (Part C Documents) which were a letter signed and issued by Suhaila Saleh ('Puan Suhaila'), MyIPO's trade marks officer, on behalf of the Registrar of Trade Marks ('Registrar'), to the first defendant company ('first defendant') and two letters signed and issued by Puan Nor Seri Mohammad ('Puan Nor') an assistant Trade Marks Officer of MyIPO, on behalf of the Registrar, to the first defendant. The plaintiff applied to this court to issue two subpoenas to Puan Suhaila and Puan Nor ('the applicants') to testify and produce documents at the trial of this case. The applicants filed this application to set aside the two subpoenas. The issues that arose were (i) whether the Registrar could apply to the court to set aside subpoenas which had been issued to the Registrar's officers on the ground that the subpoenas were frivolous as all the information needed by the plaintiff from the Registrar's officers for the trial of this case may be obtained from a search of the records of MyIPO; and (ii) in view of s. 63(1) of the Trade Marks Act 1976 ('TMA'), whether the court could order costs of this application be paid by the Registrar to the plaintiff.

Held (dismissing application with costs):

(1) The court should only set aside a subpoena if no relevant evidence can be obtained from the subpoenaed witness so as to enable the court to arrive at a just decision of the case (s. 136(1) of the Evidence Act 1950). The party applying to set aside a subpoena has the legal onus to satisfy the court that the subpoenaed witness is not in a position to give any

A evidence which is relevant to the case according to the Evidence Act 1950 and which may assist the court to decide justly. If a party who had subpoenaed a witness can discharge the onus, the subpoena does not constitute an abuse of court process and should not be set aside irrespective of the intention or motive of the party who had subpoenaed B the witness. This was because all relevant evidence which could assist the court to decide a dispute justly should be adduced in court, even if the party adducing such evidence was not actuated by the best of intentions. Whether a subpoena is set aside or not in a case depends on the exercise of the court's discretion based on the particular facts of the C case. (para 15)

(2) Section 62(1) and (2) of the TMA applies onto a rectification suit. The original suit and counterclaim did not involve any rectification of the Register. Hence, there could not be any application of s. 62(1) and (2) of the TMA in this case. Section 62(2) of the TMA does not provide for D the admissibility of MyIPO's letters in this case. Section 65(1) of the TMA only admits printed or written copies or extracts of or from the Register which have been certified by the Registrar and sealed with the Registrar's seal. It was clear that MyIPO's letters could not be admitted under s. 65(1) of the TMA. According to s. 65(2) of the TMA, a E certificate under the Registrar's hand regarding any act of the Registrar shall be *prima facie* evidence in any proceedings of the act in question (Registrar's Certificate). MyIPO's letters were clearly not the Registrar's certificate which was *prima facie* evidence under s. 65(2) of the TMA. (para 16)

F **(3)** The applicants were able to give evidence which was relevant to the original action under the Evidence Act 1950 and such evidence was necessary to enable the court to decide this case in a just manner. The defendants had classified the MyIPO's letters as Part C Documents. This meant that the plaintiff had to call the maker of the MyIPO's letters (to fulfil the rule against documentary hearsay evidence) and to tender the G primary evidence of the MyIPO's letters. If the plaintiff had not subpoenaed the applicants to testify and produce the primary evidence of the MyIPO's letters in this case, the defendants were entitled to object to the admissibility of the MyIPO's letters. In such an event, there would be an injustice to the plaintiff. The relevancy of the applicants' H evidence to this case clearly outweighed the oppression which may be caused to the applicants. The two subpoenas, therefore, could not constitute an abuse of court process. On the contrary, the two subpoenas were necessary for this court to decide this case justly. (paras 17-21)

I **(4)** The original action (based on the tort of passing off) does not concern the TMA. As such, s. 63(1) of the TMA cannot bar the court from exercising its discretion to order 'costs to follow the event' under O. 59 r. 3(2) of the RC 2012, namely costs of this application should be

awarded to the plaintiff. The applicants were officers of the Registrar who were only performing their official functions and duties in this case. Accordingly, the Registrar should be vicariously liable for the costs of this application to the plaintiff. Therefore, the Registrar ought to bear the costs of this application. (paras 23 & 24)

Case(s) referred to:

Cheng Bee Teik & Ors v. Peter Selvaraj & Anor [2005] 2 CLJ 839 CA ***(refd)***
Dato' Seri Anwar Ibrahim & Anor v. PP [2000] 3 CLJ 751 CA ***(refd)***
ECM Libra Investment Bank Bhd v. Foo Ai Meng & Ors [2013] 1 LNS 99 CA ***(refd)***
Godrej Sara Lee Ltd v. Siah Teong Teck & Anor [2007] 10 CLJ 255 HC ***(refd)***
Ho Tack Sien & Ors v. Rotta Research Laboratorium SpA & Anor; Registrar of Trade Marks (Intervener) & Another Appeal [2015] 4 CLJ 20 FC ***(refd)***
How Paik Too v. Mohideen [1967] 1 LNS 57 FC ***(refd)***
Ismail v. Hasnul & Another Appeal [1967] 1 LNS 60 FC ***(refd)***
KTL Sdn Bhd & Anor v. Leong Oow Lai & Other Cases [2014] 1 LNS 427 HC ***(refd)***
Malayan Banking Bhd v. Shariffudin Hassan & Another Case [2013] 1 LNS 688 HC ***(refd)***
Wong Sin Chong & Anor v. Bhagwan Singh & Anor [1993] 4 CLJ 345 SC ***(refd)***

Legislation referred to:

Evidence Act 1950, s. 136(1)
Rules of Court 2012, O. 34 r. 2(2)(e)(ii), O. 38 r. 14(1), (3), (4), (5), O. 59 rr. 3(2), 21, O. 92 r. 4
Trade Marks Act 1976, ss. 45(1)(a), 62(2), 63(1), 64, 65(1), (2)

For the plaintiff - Revanthi Krishnan & Vijayaletchumi Muniandy; M/s G Reshua & Partners
For the Registrar of Trade Marks - Azrul Shahreen Abdul Aziz, Intellectual Property Corporation of Malaysia

Reported by Suhainah Wahiduddin

JUDGMENT

Wong Kian Kheong JC:

Issues

[1] In court encl. No. 50 (this application), the following two questions arise:

(a) whether the Registrar of Trade Marks (Registrar) can apply to court to set aside subpoenas which have been issued to the Registrar's officers (subpoenas had been applied for by the plaintiff company (plaintiff)) on the ground that the subpoenas are frivolous as all the information needed by the plaintiff from the Registrar's officers for the trial of this case may be obtained from a search of the records of Intellectual Property Corporation of Malaysia (MyIPO); and

(b) if the court dismisses this application, in view of s. 63(1) of the Trade Marks Act 1976 (TMA), can the court order costs of this application be paid by the Registrar to the plaintiff?

A **Background**

[2] In this case:

(a) the plaintiff had filed an action (original action) against five defendants (defendants) for the tort of passing off in respect of a mark used by the
B plaintiff in its business; and

(b) the defendants had made various counterclaims against the plaintiff (counterclaim).

[3] During pre-trial case management of this case:

C (a) the plaintiff and defendants had agreed for the original action and counterclaim to be tried together; and

(b) pursuant to O. 34 r. 2(2)(e)(ii) of the Rules of Court 2012 (RC), the defendants had classified the following three letters issued by MyIPO (MyIPO's letters) as "Part C" documents (Part C documents):

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(i) a letter dated 30 June 2015 signed and issued by Puan Suhaila binti Saleh (Puan Suhaila), MyIPO's Trade Marks Officer, on behalf of the Registrar, to the first defendant company (first defendant); and

(ii) two letters, both dated 16 July 2015, signed and issued by Puan Nor
E Seri binti Mohammad (Puan Nor), an Assistant Trade Marks Officer of MyIPO, on behalf of the Registrar to the first defendant.

[4] As the defendants had classified MyIPO's Letters as Part C documents, the plaintiff applied to this court to issue two subpoenas to Puan Suhaila and Puan Nor (two subpoenas) to testify and produce documents at
F the trial of this case.

[5] This application had originally been filed by Puan Nor only. On the hearing date of this application, the applicant's learned counsel applied orally to amend this application to include an application by Puan Suhaila (oral application). The plaintiff's learned counsel, to her credit, did not object to
G the oral application. Accordingly, I allow the oral application and this application is thus made by both Puan Suhaila and Puan Nor (collectively referred to in this judgment as the "applicants").

Submission Of Applicants And Plaintiff

H **[6]** The applicants' learned counsel had forwarded the following contentions, among others, for this court to set aside the two subpoenas:

(a) based on the Federal Court's judgment delivered by Zulkefli Makinudin CJ (Malaya) in *Ho Tack Sien & Ors v. Rotta Research Laboratorium SpA & Anor, Registrar of Trade Marks (Intervener) & Another Appeal* [2015] 4
I CLJ 20 at paras. 1, 24, 26, 29 and 46:

(i) in a suit to rectify the Register of Trade Marks (Register) under s. 45(1)(a) TMA (Rectification Suit), there is no necessity to cite the Registrar in the rectification suit. This is because the evidence of the Registrar is not material to prove a trade mark infringement and the Registrar is not a key witness to establish likelihood of confusion; and

(ii) according to s. 62(2) TMA, *in lieu* of the Registrar appearing and being heard in the rectification suit, the Registrar may submit to the court a statement in writing signed by the Registrar, giving particulars of the proceedings before the Registrar in relation of the matter in issue or of the grounds of any decision given by the Registrar affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within the Registrar's knowledge, as the Registrar thinks fit (Registrar's statement), and the Registrar's statement shall be deemed to form part of the evidence in the rectification suit;

(b) the two subpoenas are frivolous because under s. 65(1) and (2) TMA, the plaintiff need not call the applicants as witnesses and the plaintiff may just tender copies of searches of the register as evidence in this case; and

(c) the applicants cited the Court of Appeal's judgment delivered by Arifin Zakaria CJ (as he then was) in *Cheng Bee Teik & Ors v. Peter Selvaraj & Anor* [2005] 2 CLJ 839; [2005] 4 MLJ 301.

[7] The plaintiff resisted this application on the following grounds, among others:

(a) the TMA does not allow the applicants to apply to court to set aside the two subpoenas;

(b) the plaintiff had to call the applicants to testify and produce MyIPO's Letters in this case because the defendants had classified MyIPO's Letters as Part C documents; and

(c) the plaintiff cited, among others, the following cases to oppose this application:

(i) the judgment of Ramly Ali J (as he then was) in the High Court case of *Godrej Sara Lee Ltd v. Siah Teong Teck & Anor* [2007] 10 CLJ 255; [2007] 7 MLJ 153; and

(ii) Gunalan Muniandy JC's decision in the High Court in *Malayan Banking Bhd v. Shariffudin Hassan & Another Case* [2013] 1 LNS 688.

Court's Power To Set Aside Subpoenas

[8] Sections 62 to 65 TMA provide as follows:

62. Hearing of Registrar

(1) In any legal proceedings in which the relief sought includes alteration or rectification of the Register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Registrar, in lieu of appearing and being heard, may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation of the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and such statement shall be deemed to form part of the evidence in the proceedings.

63. Costs

(1) In all proceedings before the Court under this Act, the Court may award to any party such costs as it may consider reasonable and the costs as it may consider reasonable and the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any of the other parties.

(2) In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court, be enforced in the same manner as a judgment or order of the Court to the same effect.

64. Mode of giving evidence

(1) In all proceedings before the Registrar under this Act, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which he thinks fit, the Registrar may take evidence *viva voce in lieu* of or in addition to evidence by declaration.

(2) Any such statutory declaration may, in the case of appeal, be used before the Court *in lieu* of evidence by affidavit, but if so used, shall have all the incidents and consequences of evidence by affidavit.

(3) In any action or proceedings relating to a trade mark or trade name, the Registrar or the Court, as the case may be, shall admit evidence of the usages of the trade concerned or evidence of business usages in the provision of the services in question, and evidence of any relevant trade marks or trade name or business name or getup legitimately used by other persons.

65. *Sealed copies to be evidence*

(1) Printed or written copies or extracts of or from the Register purporting to be certified by the Registrar and sealed with his seal shall be admissible as evidence in any proceedings before any court of law without further proof or production of the originals.

(2) A certificate purporting to be under the hand of the Registrar as to any act which he is authorized under this Act to perform and which he has or has not performed, as the case may be, shall be prima facie evidence in any proceedings before any court of law of his having or not having performed the act.

(emphasis added).

[9] It is clear that the TMA does not provide any power for the court to set aside a subpoena issued under O. 38 r. 14(1) of the RC.

[10] Order 38 r. 14(3), (4) and (5) of the RC provide as follows:

Order 38 rule 14

…

(4) *The Registrar may, in any case, revoke a subpoena upon an application by any person or on his own motion.*

(5) *Any party who is dissatisfied with any decision of the Registrar made under this rule may apply to a Judge for a review of that decision.*

(6) An application under this rule shall be made by a notice of application supported by an affidavit, within fourteen days of that decision.

(emphasis added).

[11] Except for O. 38 r. 14(3) and (4) of the RC, there is no express provision in the RC or any other written law which empowers the court to set aside a subpoena.

[12] The following appellate cases have held that the court has the inherent jurisdiction to set aside a subpoena:

(a) Raja Azlan Shah J (as His Majesty then was) decided as follows in the Federal Court case of *Ismail v. Hasnul & Another Appeal* [1967] 1 LNS 60; [1968] 1 MLJ 108, at 109-110:

> *The practice in all courts has been that a subpoena may be issued against anybody,* be he a Minister of the Government or a non-entity. It cannot be gainsaid that a Minister has any more privilege than that enjoyed by a member of the public. Injustice will arise if equals are treated unequally. *But the court possesses inherent jurisdiction to see that this privilege is properly exercised and in a proper case can restrain its abuse: see Raymond Tapson* (1882) 22 Ch D 435.

(emphasis added); and

(b) Ismail has been followed by Mohamed Azmi SCJ in the Supreme Court case of *Wong Sin Chong & Anor v. Bhagwan Singh & Anor* [1993] 4 CLJ 345; [1993] 3 MLJ 679, at 686.

[13] As the court has the inherent jurisdiction to set aside a subpoena according to *Ismail* and *Wong Sin Chong*, the court should have inherent powers under O. 92 r. 4 RC to set aside a subpoena which constitutes an abuse of court process.

[14] As to how the court may exercise its inherent jurisdiction or inherent power under O. 92 r. 4 RC to set aside a subpoena, I refer to the following appellate cases (in chronological order):

(1) according to *Ismail*, at pp. 111 and 112:

> In three well-known instances the court has set aside a subpoena as an abuse of its process. In *R Hurle-Hobbs* [1945] KB 165 the court had no power to issue it. Steel Savory 8 TLR 94 was a case of oppression. In *R Baines* 25 TLR 79 the witness could give no relevant evidence. It is plain that these decisions do not enumerate all the cases which fall under this head. Each case must in the last analysis depend on the evaluation of its own facts. The short question which this court has to enquire is whether its process issued against the appellants has been abused. …
>
> …
>
> For the above reasons it is difficult to see in what way the appellants can give relevant evidence to assist the defence. In the particular circumstances of this particular case the court has a right to protect them from the practice and process of this court being used simply for a matter that is misconceived and not for the purposes of justice.

(emphasis added);

(2) it was held in *Wong Sin Chong*, at pp. 349, 350 and 352 (CLJ); pp. 686, 687 and 690 (MLJ), as follows:

> *The right of a party to the attendance of witnesses is a crucial part of our judicial system, but the right must be protected against any oppression or abuse. Thus in Raymond v. Tapson [1883] 22 Ch D 430, it was held that any party may, without leave of the court, issue a subpoena for the examination of a witness at any stage of an action; but the court will exercise a control over the privilege to prevent it being oppressively used.* In that case, the plaintiffs had subpoenaed a solicitor, who had acted for both parties in a mortgage transaction, in order to examine him with respect to the moneys received by him on account of both parties. The court held that the plaintiff was entitled to issue the subpoena and to examine the witness. *But, where no useful result would be obtained by the attendance of a witness, the subpoena should be refused – see Re Mundell, Fenton v. Cumberlege (1883) 52 LJ Ch 756.*
>
> …

In every case, the onus is on the party issuing the subpoena to show the materiality of the witness for the just decision of the case, in that it outweighs any oppression that may be caused to the party objecting.

…

Further, *there is no explanation for the delay in the issue of the subpoena, notwithstanding the notice given earlier, and having regard to its timing, there could be no doubt, on balance, that it was an oppressive subpoena, with a mala fide motive of depriving the Wongs of the services of Dato' Wrigglesworth in the middle of the hearing. In the circumstances, the subpoena was an abuse of process and as such the court had a duty to set it aside. In addition, the failure of the subpoena to identify the documents to be produced, particularly after consent was withheld by Mr Bhagwan Singh to the inclusion of all relevant documents in the agreed bundle of documents notwithstanding the agreement already given by the second respondent to such inclusion, did not assist Mr Bhagwan Singh at all on the issue of bona fide.*

(emphasis added);

(3) *Dato' Seri Anwar Ibrahim & Anor v. PP* [2000] 3 CLJ 751; [2000] 3 MLJ 638 concerned a criminal case where a witness is "summoned" (not subpoenaed) by a "summons" in Form 31 in the Second Schedule to the Criminal Procedure Code (Form 31), to give evidence. Form 31 provides, among others, that a witness is summoned to testify in a criminal case because the witness is "likely to be able to give material evidence" regarding the criminal complaint. In *Dato' Seri Anwar bin Ibrahim*, at pp. 756-757 (CLJ); p. 641 and pp. 642-643 (MLJ), Lamin PCA delivered the following judgment of the Court of Appeal:

Section 136 of the [Evidence Act 1950] is in point. It reads:

Court to decide as to admissibility of evidence

(1) *When either party proposes to give evidence of any fact, the court may ask the party proposing to give the evidence in what manner the aIleged fact, if proved, would be relevant; and the court shall admit the evidence if it thinks that the fact, if proved, would be relevant, and not otherwise.*

The very title of the section does not admit any doubt that it is the court to decide on the question of relevancy before the evidence can be admitted.

…

In law a party cannot be denied of the benefit of a witness who is prepared to give material or relevant evidence. *He has a right to call such a witness and therefore a summons will only issue to such a person. Hence the wording of [Form 31]. He has no right legal or otherwise to call any person not in possession of such evidence. So in the final analysis it is the court that decides and has control in the matter of calling witnesses in a criminal case so that only material witnesses will be summoned. The*

process as provided in the Criminal Procedure Code and s 136 of the Act are means to control the gathering of evidence so that only material and relevant evidence are admitted.

(emphasis added); and

(4) in the Court of Appeal case of *ECM Libra Investment Bank Bhd v. Foo Ai Meng & Ors* [2013] 1 LNS 99; [2013] 3 MLJ 35, at sub-paras. 7(c) to (e), Hamid Sultan J (as he then was) decided as follows:

7(c) *the law in respect of setting aside of subpoena is well settled. Any witness who has seen the facts or who knows the facts can be compelled to assist the court and should assist the court by giving evidence unless the exception applies. In Harmony Shipping Co SA v. Davis and Others [1979] 3 All ER 177, the English Court of Appeal asserted that aside from issues of oppression the subpoena must be obeyed. The court stated:*

> That principle is established in the case of a witness of fact: for the plain, simple reason that the primary duty of the court is to ascertain the truth by the best evidence available. *Any witness who has seen the facts or who knows the facts can be compelled to assist the court by giving that evidence* …
>
> In this particular case Mr Davis has been subpoenaed by the defendants. It seems to me that that is very right and proper. It was suggested that the subpoena should be set aside. *As far as I know, no subpoena ad testificandum has ever been set aside except at the instance of the witness himself when he has claimed that it would be oppressive to make him answer that subpoena. Otherwise a subpoena ad testificandum must be obeyed by the witness. He must come to the court and be ready to give his evidence and answer such questions as the judge permits to be answered.*

We must say here that the above case and many other cases in this area of jurisprudence cannot be taken as the authority to compel persons who have no nexus to the case or where their evidence will not be relevant or admissible to give evidence readily for the purpose of assisting the litigants (as opposed to assisting the court to arrive at the truth) that too to arrive at the quantum. The test to compel is a strict test. The witnesses who can be compelled are those 'who have seen the facts or who know the facts' and this will usually relate to liability and rarely to quantum. Such strictures may not be applicable if the witness voluntarily gives evidence on the issue of liability or quantum;

(d) *in the Malaysian context a litigant under the rules of court has a right to issue a subpoena and sustain the same provided it is not oppressive or an abuse of process of court and is relevant and material to the case and is not frivolous or scandalous (see Ong Jane Rebecca v. Lim Lie Hoa and others (Lim Lie Hoa, third party).* …

(e) *it is equally well settled in every case, the onus is on the party issuing the subpoena to show the materiality of the witness for the just decision of the case, in that it outweighs any oppression that may be caused to the party objecting (Wong Sin Chong & Anor v Bhagwan Singh & Anor [1993] 3 MLJ 679). In the instant case the learned judge has given her grounds of decision. The appellant has not demonstrated to our satisfaction that an error in the exercise of discretion has indeed occurred. We also find it difficult to fathom how this witness will be relevant and material to the plaintiff's case, be it on liability or quantum.*

(emphasis added).

[15] I am of the following view regarding the court's exercise of inherent jurisdiction and/or inherent power under O. 92 r. 4 RC to set aside a subpoena:

(a) the court should only set aside a subpoena if no relevant evidence can be obtained from the subpoenaed witness so as to enable the court to arrive at a just decision of the case – *Ismail*, at p. 112. Section 136(1) of the Evidence Act 1950 (EA) provides that the court "shall admit the evidence if it thinks that the fact, if proved, would be relevant, and not otherwise". Accordingly, the evidence of a subpoenaed witness should be "relevant" under the EA. Section 3 of the EA defines the term "relevant" as "one fact is said to be relevant to another when the one is connected with the other in any of the ways referred to in the provisions of (EA) relating to the relevancy of fact". According to s. 5 EA, evidence may be given of the existence or non-non-existence of:

(i) every "fact in issue" (defined in s. 3 of the EA as "any fact from which, either by itself or in connection with other facts, the existence, non-existence, nature or extent of any right, liability or disability asserted or denied in any suit or proceeding necessarily follows"). The term "fact in issue" has been explained by Ong Hock Thye FJ (as he then was) in the Federal Court case of *How Paik Too v. Mohideen* [1967] 1 LNS 57; [1968] 1 MLJ 51, at 52; and

(ii) every fact declared by EA as relevant, namely a fact which is relevant under ss. 6 to 55 (contained in Chapter 2 EA which is entitled "Relevancy of Facts");

(b) if a subpoenaed witness cannot give any relevant evidence in a case within the meaning of EA so as to assist the court to decide the case in a just manner, the application and service of the subpoena on the witness, constitutes an abuse of court process and the subpoena should be set aside by the court – *Ismail*, at p. 111;

(c) the party applying to set aside a subpoena has the legal onus to satisfy the Court that the subpoenaed witness is not in a position to give any evidence which is relevant to the case according to the EA and which may assist the court to decide justly *(Onus)*;

(d) if a party who has subpoenaed a witness, can discharge the *Onus*, the subpoena does not constitute an abuse of court process and should not be set aside irrespective of the intention or motive of the party who has subpoenaed the witness. This is because all relevant evidence which can assist the court to decide a dispute justly should be adduced in court, even if the party adducing such evidence is not actuated by the best of intentions; and

(e) whether a subpoena is set aside or not in a case, depends on the exercise of the court's discretion based on the particular facts of the case – please see *Ismail*, at p. 111. Accordingly, judgments on cases regarding the setting aside of subpoenas or otherwise, are purely illustrative and have no binding effect from the view point of the doctrine of *stare decisis*.

Should Court Set Aside Two Subpoenas?

[16] Firstly, I accept the contention by the plaintiff's learned counsel that the following provisions in TMA do not support this application:

(a) s. 62(1) and (2) TMA apply only to a rectification suit. The original suit and counterclaim do not involve any rectification of the Register. Hence, there cannot be any application of s. 62(1) and (2) TMA in this case;

(b) s. 62(2) TMA deems the Registrar's statement to be part of the evidence in a rectification suit. Section 62(2) TMA does not however provide for the admissibility of MyIPO's Letters in this case;

(c) s. 65(1) TMA only admits printed or written copies or extracts of or from the Register which have been certified by the Registrar and sealed with the Registrar's seal. It is clear that MyIPO's Letters cannot be admitted under s. 65(1) TMA; and

(d) according to s. 65(2) TMA, a certificate under the Registrar's hand regarding any act of the Registrar shall be *prima facie* evidence in any proceedings of the act in question (Registrar's Certificate). MyIPO's Letters are clearly not the Registrar's Certificate which is *prima facie* evidence under s. 65(2) TMA.

[17] I am of the view that the applicants are able to give evidence which is relevant to the original action under the EA and such evidence is necessary to enable the court to decide this case in a just manner. Such a decision is premised on the following reasons:

(a) MyIPO's Letters had been issued by the applicants on behalf of the Registrar. MyIPO's Letters informed the first defendant that the Registrar had objected to the first defendant's applications to register the first defendant's trade mark on the ground, among others, that the first defendant's trade mark was likely to deceive or confuse the public

(Likelihood Of Deception/Confusion) with regard to an earlier registered trade mark (which had been acquired by the plaintiff but the name of the owner of this registered trade mark had not been changed to the plaintiff);

(b) the Likelihood Of Deception/Confusion will definitely support the original action regarding the tort of passing off;

(c) the defendants had classified MyIPO's Letters as Part C documents. This means that the plaintiff had to call the maker of MyIPO's Letters (to fulfil the rule against documentary hearsay evidence) and to tender the primary evidence of MyIPO's Letters – please see *KTL Sdn Bhd & Anor v. Leong Oow Lai & Other Cases* [2014] 1 LNS 427; [2014] MLJU 1405, at para. 34; and

(d) if the plaintiff had not subpoenaed the applicants to testify and produce the primary evidence of MyIPO's Letters in this case, the defendants were entitled to object to the admissibility of MyIPO's Letters. In such an event, there would be an injustice to the plaintiff.

[18] As an alternative to my finding in the above para. 17, I hold that the applicants have failed to discharge the *Onus* and on this ground alone, this application should be dismissed.

[19] I do not see how the two subpoenas can oppress the applicants. In any event, even if it is assumed that the two subpoenas do oppress the applicants, I find that the relevancy of the applicants' evidence to this case (please see the above para. 17) clearly outweighs any oppression which may be caused to the applicants.

[20] Finally, I do not find that the two subpoenas constitute an abuse of court process. On the contrary, in view of the defendants' classification of MyIPO's Letters as Part C Documents, I am of the view that the two subpoenas are necessary for this court to decide this case justly.

[21] The cases cited by the applicants' learned counsel, with respect, do not concern applications to set aside subpoenas.

[22] In view of the above reasons, this court is constrained to dismiss this application.

Can Court Award Costs Of This Application Against Registrar?

[23] Section 63(1) TMA provides that in all proceedings under TMA, the Registrar shall not be ordered to pay the costs of any party. This application is not a proceeding under the TMA. As explained above, the original action (based on the tort of passing off) does not concern the TMA. As such, s. 63(1) TMA cannot bar the court from exercising its discretion to order "costs to follow the event" under O. 59 r. 3(2) of the RC, namely costs of this application should be awarded to the plaintiff (who has resisted successfully this application).

[24] It is not disputed that the applicants are officers of the Registrar who are only performing their official functions and duties in this case. Accordingly, the Registrar should be vicariously liable for the costs of this application to the plaintiff. I therefore order the Registrar (not the applicants) to bear the costs of this application.

[25] In the exercise of the court's discretion under O. 59 r. 21 of the RC, I fix a sum of RM1,500 as costs to be paid by the Registrar to the plaintiff for this application. This is because although this application raises novel questions of law regarding ss. 63 and 65 of the TMA, this application has been made by the Registrar in the public interest to ensure that the Registrar's officers do not have to expend valuable time, effort and expense to attend court to testify as witnesses unless the evidence of the Registrar's officers is relevant to the case in question and can assist the court to decide the dispute in a just manner.

Court's Decision

[26] Based on the above reasons, this application is dismissed with costs of RM1,500 to be paid by the Registrar (not the applicants) to the plaintiff.